

**REMARKS**

Claims 1-30 are pending in the present application. The Examiner has rejected claims 1-30. These rejections are respectfully traversed, for the reasons as set forth below.

**35 U.S.C. § 101, Statutory Type-Double Patenting**

The Examiner has rejected claims 17-30 under 35 U.S.C. § 101 as claiming the same invention as that of claims 4-17 of co-pending application no. 09/842,899 (U.S. 2002/0160748) '748'. This provisional rejection is respectfully traversed.

Applicants submit that this provisional double patenting rejection is premature in light of the future prosecution of provisional application '748, and further in light of the future prosecution of the present application. Applicants note that a Terminal Disclaimer may be filed in due course, to overcome a non-provisional statutory rejection if necessary. The possibility that the claims may change in both of the above mentioned presently pending applications is believed to render the Examiner's provisional rejection unripe at this time.

Accordingly, Applicants submit that this provisional rejection is inappropriate at for the reasons as stated above, Applicants respectfully request this rejection be suspended and/or withdrawn.

**Claim Rejections – 35 U.S.C. § 103**

The Examiner has rejected claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over Tsoukas et al. (WO 97/41654) in view of Dennis (WO 99/33293). This rejection is respectfully traversed.

Applicants submit that the Examiner has relied upon the disclosure of Tsoukas as allegedly teaching a method for service negotiation including all of the claim limitations of

claim 1, with the exception of a service creation. The Examiner has further relied upon the disclosure of Dennis in an effort to provide the insufficiencies not disclosed in Tsoukas, to render claim 1 obvious. Applicants disagree with the Examiner's alleged obviousness rejections for at least the following reasons.

**All Claim Limitations Not Disclosed**

Even if the disclosures of Tsoukas and Dennis were combinable, which Applicants do not admit to, the combination of references fails to teach or suggest all of the claim limitations of independent claim 1.

Applicants submit that the disclosure of Tsoukas is directed to a method and system for providing a subscriber of a mobile telephone network with updated information. Tsoukas provides a database of stored customer defined profiles of subscribers. A customer may request this information independent of the user's current location, or in the event of a change of location.

Applicants submit that Tsoukas does not teach comparing a request with user information and associated network information and providing the requested service based on the comparison, as disclosed in claim 1. The disclosure of Tsoukas is limited to updating user information on a periodic basis, and providing a user with the information over a specified duration of time. (

Applicants submit that Dennis is directed to a system and method for storing a user profile such that the user profile may be updated periodically, and the related information kept current with the user. Dennis further discloses the location of the user as a measurement parameter used for a user information update. The Examiner has alleged

that Dennis teaches the detailed steps of service creation in pages 7-19, Applicants disagree.

After reviewing pages 7-19 of Dennis, Applicants submit that Dennis discloses various preferential categories that may be related to a user's profile, for example, stock, credit card, travel and sports information. A user may make a request for these types of information based on the user's profile information. The user requests are handled by SCP 109, which maintains the user's profile and receives information regarding the requests of the user from other sources. See page 14, line 20. Applicants submit that the disclosure of Dennis is generally limited to the disclosure of applications and programs that may be requested by a user and related to the user profile.

Applicants can find no teaching or suggesting, in Dennis, for comparing a request with user information and associated network information and providing the requested service based on the comparison, as disclosed in claim 1.

Accordingly, Applicant submit that claim 1 and those claims dependent thereon are allowable over the prior art cited to record. Withdrawal of this rejection is kindly requested.

Applicants submit that independent claims 4, 7, 12, 17 and 24 contain somewhat similar subject matter to independent claim 1. Accordingly, for at least the reasons as set forth above with regard to claim 1, Applicants submit that claims 4, 7, 12, 17 and 24 and those claims dependent thereon are allowable over the prior art cited to record. Withdrawal of the rejection is kindly requested.

**References Not Combinable**

Applicants direct the Examiner's attention to two cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 50 USPQ2d 1614 (Fed.Cir. 1999) and In re Kotzab, 55 USPQ2d 1313 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill art, or in some cases, the nature of the problem to be solved. See Dembiczak 50 USPQ2d at 1614. For example, in Kotzab, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. Broad conclusive statements standing alone are not "evidence". The Examiner alleges that service creation for a wireless network would provide one skilled in the art with a recognized advantage if the service creation was implemented for customizing and updating user information. Applicants submit that the above reasoning is insufficient as the required motivation to combine Tsoukas and Dennis. Further, the above alleged motivation appears on its face to be broad and conclusory,

lacking specificity, and silent regarding the evidence required to combine Tsoukas and Dennis.

Accordingly, Applicants respectfully submit that claim 1 is allowable for at least the reason that the Examiner has failed to establish a proper prima facie case of obviousness under 35 U.S.C. 103(a) in view of Dembiczak and Kotzab.

Notwithstanding the holding of Dembiczak and Kotzab and its applicability to the instant application, the Examiner relies on the purposes served by the present invention to support the alleged motivation for combining the receiving of a service negotiation request with the creation of a service.

The above mentioned features are essentially analogous to some of the claimed features disclosed in claim 1, but neither Tsoukas nor Dennis suggest such an advantage or purpose served in their respective descriptions. There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself. In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Accordingly, claim 1 is allowable for at least the additional reason that the Examiner has failed to make out a prima facie case of obviousness, since he has borrowed the very purpose or advantage served by the present application to support his alleged motivation to combine Tsoukas with Dennis.

### **CONCLUSION**

Accordingly, in view of the above remarks, reconsideration of the objections and rejections and allowance of each of claims 1-30 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

  
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